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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,692	12/08/2003	Kurt R. Thielen	33826/US/2	4306
<div>7590 01/09/2009</div> <div>Stuart R. Hemphill DORSEY & WHITNEY LLP Intellectual Property Department 50 South Sixth Street, Suite 1500 Minneapolis, MN 55402-1498</div> <div>EXAMINER BRINEY III, WALTER F</div> <div>ART UNIT 2614</div> <div>PAPER NUMBER</div> <div>MAIL DATE 01/09/2009</div> <div>DELIVERY MODE PAPER</div>				

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/730,692

Applicant(s)

THIELEN, KURT R.

Examiner

WALTER F. BRINEY III

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
4a) Of the above claim(s) 1-20 and 41-52 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 21-40 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date 4/26/2004: 6/10/2008
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group II in the reply filed on 21 October 2008 is acknowledged. Accordingly, **claims 1-20 and 41-52** are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

10 A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

20 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 21-32 and 39-40 are rejected under 35 U.S.C. 102(b) and 103(a) as being unpatentable over US Patent Application Publication 2001/0004397 A1 (published 21 June 2001) (“*Kita*”) in view of US Patent Application Publication 2003/0055516 A1 (filed 29 June 2001) (“*Gang*”).**

25 **Claim 21** is limited to a player for storing and playing back media content received from a content source pursuant to stored user preferences. Similarly, *Kita* discloses a “Body-Wearable Type Music Reproducing Apparatus and Music

Reproducing System Which Comprises Such Music Reproducing Apparatus.” The music reproducing apparatus 100/2400 of *Kita* is generally conceived as a wristwatch with music reproduction components 211 and 212 as seen in figs.4 and 27. In operation, the music reproducing apparatus cooperates with an external device 800 that in turn

5 downloads music from a music distribution service site. *See Kita* at ¶¶ 155, 172, fig.4.

The music reproducing apparatus 100/2400 external device 800 correspond to the claimed player while the music distribution service site corresponds to the claimed content source. *Kita*, however, is absolutely silent regarding how device 800 determines which music files are downloaded from the music distribution service site. Accordingly,

10 *Kita* fails to disclose a player that plays back media content received from a content source pursuant to stored user preferences. This deficiency will be treated *infra* apropos the third element of this claim.

The body of this claim includes three elements: (1) a storage medium, (2) a transceiver link a transceiver link for communicating with the content source and (3) a first instruction component. Concerning the first element, this claim requires a storage medium for storing media content for playback. *Kita* discloses a memory card 209 for storing music received from a music distribution service site. *Kita* at ¶ 172.

Concerning the second element, this claim requires a transceiver link for communicating with the content source. *Kita* discloses LAN interface 808 and MODEM 20 809 for establishing communication with a music distribution service site corresponding to the claimed content source. *Id.* at ¶ 164, fig.4.

Concerning the third element, this claim requires the following:

“a first instruction component for establishing communication with the content source using the transceiver link and using such link for downloading onto the storage medium one or more content files responsive to stored user content preferences.”

- 5 *Kita* likewise discloses a control unit 801 that causes either LAN interface 808 or MODEM 809 to download music from a music distribution service site corresponding to the claimed content source. *See id.* at ¶ 164, fig.4. *Kita*, however, is silent regarding how device 800 determines which music files are downloaded from the music distribution service site. Accordingly, *Kita* fails to disclose that the music downloaded by external
- 10 device 800 is downloaded responsive to *stored user content preferences*. Since it is not readily apparent whether such a functional limitation distinguishes the claimed invention from *Kita* this rejection will proceed as a 102/103 rejection. On the one hand, the functional limitation is viewed as an intended use that fails to positively limit the structure of the claimed player since the downloading based on preferences ostensibly
- 15 affects only the operation of the content source. On the other hand, the functional limitation is viewed as requiring some incidental physical changes in the claimed player. In the first instance, *Kita* anticipates the claimed player according to the foregoing. In the second instance, *Kita* fails to anticipate the claimed player since *Kita* does not disclose downloading music from a music distribution service site based on stored user
- 20 preferences.

Notwithstanding this deficiency in *Kita*, the prior art makes obvious using stored user preferences to assist in downloading new music from a music distribution service site. For example, *Gang* discloses an invention entitled “Using a System for Prediction of Musical Preferences for the Distribution of Musical Content over Cellular Networks.”

Gang discloses storing a user profile with preferences to direct the downloading of new music. *Gang* at ¶¶ 5-7. In this way, *Gang* eases the difficulty of picking out new songs by reducing the time required and effort necessary for a user to comb through a database of music. See *id.* at ¶¶ 3-4 (disclosing as a goal the reduction of airtime required to browse for new music.) Accordingly, one of ordinary skill in the art at the time of Applicant's invention would have found using stored user preferences to assist in downloading music obvious. Therefore, *Kita* in view of *Gang* makes obvious all limitations of the claim.

Claim 22 is limited to the player of claim 21. This claim requires the following:

“wherein the player further comprises a first docking station connector used as two or more of: a wired content communication interface, a power charging interface, a digital content output interface, an analog content output interface, and an electronic control interface.”

Kita discloses an interface 701 for receiving, at least, wired content from external device 800 and power from external device 800. *Kita* at ¶¶ 127-28. Therefore, *Kita* in view of *Gang* makes obvious all limitations of the claim.

Claim 23 is limited to the player of claim 21. This claim requires the following:

“wherein the player further comprises a second docking station connector used for a vehicle docking connector with an analog content output, a digital content output and a power input.”

First, it is not apparent that the capabilities of the claimed vehicle docking connector have any bearing on the structure of the claimed second docking station connector.

Accordingly, the *Kita* interface 701 for receiving, at least, wired content from external device 800 and power from external device 800 corresponds to the claimed second

docking station connector of this claim. *Kita* at ¶¶ 127-28. Therefore, *Kita* in view of *Gang* makes obvious all limitations of the claim.

Claim 24 is limited to the player of claim 21. This claim requires that the player comprises a rechargeable battery and battery charging circuitry. *Kita* similarly discloses
5 a rechargeable battery 216 and associated charger 702. *Kita* at ¶¶ 127-28. Therefore, *Kita* in view of *Gang* makes obvious all limitations of the claim.

Claim 25 is limited to the player of claim 21. This claim requires that the player is configured to use as a content source one or more of a personal computer, a peer player or a website. Likewise, *Kita* discloses downloading music from a music distribution
10 service website. *Id.* at ¶ 155. Therefore, *Kita* in view of *Gang* makes obvious all limitations of the claim.

Claim 26 is limited to the player of claim 21. This claim requires that the transceiver link comprises a wireless transceiver link. In addition to using a PC to connect to the music distribution service site, *Kita* discloses using a mobile terminal 914
15 to wireless connect to the service site. *Id.* at ¶ 213, fig.17B. Therefore, *Kita* in view of *Gang* makes obvious all limitations of the claim.

Claim 27 is limited to the player of claim 21. This claim requires that the transceiver link comprises a wired transceiver link. *Kita* discloses using either a MODEM 809 or a LAN connection 808 to establish a wired connection to the music
20 distribution service site. *Id.* at ¶ 155, fig.4. Therefore, *Kita* in view of *Gang* makes obvious all limitations of the claim.

Claim 28 is limited to the player of claim 21. This claim requires that the transceiver link comprises a wireless local area network. *Kita* discloses using either a MODEM 809 or a LAN connection 808 to establish a wired connection to the music distribution service site. *Id.* at ¶ 155, fig.4. However, the Examiner takes Official Notice
5 that replacing a wired LAN with a wireless LAN, such as that provided in accordance with the IEEE 802.11 family, was well known at the time of Applicant's invention. Accordingly, one of ordinary skill in the art would have found using a wireless LAN obvious as an equivalent means for connection between the external device 800 of *Kita* and the music distribution service site. Therefore, *Kita* in view of *Gang* makes obvious
10 all limitations of the claim.

Claim 29 is limited to the player of claim 21. This claim requires the following:
“a second instruction component for managing content downloading, the second instruction component enabling a user to define for communication to a content source user content preferences based on one or more of the following: a song
15 title; a playlist of song titles; a genre associated with a content file; an album title; an artist; or another item of metadata associated with a content file.”

According to the combination of *Kita* and *Gang*, one of ordinary skill in the art at the time of Applicant's invention would have found using stored user preferences obvious to reduce the time required for a user to select new music from a music distribution server.

20 See the rejection of claim 21, *supra*. Furthermore, *Gang* discloses that in providing user preferences, the user provides feedback to update the preferences. *Gang* at ¶ 77-78. Such feedback includes metadata, such as how much a user likes a particular song, is recorded in the player device and then uploaded to the content provider. *Id.* Therefore, *Kita* in view of *Gang* makes obvious all limitations of the claim.

Claim 30 is limited to the player of claim 21. This claim requires the following:

5 “a second instruction component for managing content downloading, the second instruction component enabling a user to define for communication to a content source user content preferences specifying a schedule for when content is downloaded to the player.”

According to *Gang*, a user can also establish, as a preference, subscription to a daily music recommendation. *Id.* at ¶¶ 83-84. Therefore, *Kita* in view of *Gang* makes obvious all limitations of the claim.

Claim 31 is limited to the player of claim 21. This claim requires that the player

10 stores a usage file that tracks content playback and communicates the usage file to the content source. According to the combination of *Kita* and *Gang*, one of ordinary skill in the art at the time of Applicant's invention would have found using stored user preferences obvious to reduce the time required for a user to select new music from a music distribution server. *See* the rejection of claim 21, *supra*. Furthermore, *Gang*
15 discloses that in providing user preferences, the user provides feedback to update the preferences. *Id.* at ¶ 77-78. Such feedback includes metadata, such as whether a song has been played, is recorded in the player device and then uploaded to the content provider. *Id.* Therefore, *Kita* in view of *Gang* makes obvious all limitations of the claim.

Claim 32 is limited to the player of claim 31. This claim requires the following:

20 “wherein the content source has stored user content preference information and the usage file is configured for analysis by the content source and for facilitating modification of the stored user content preferences in response to the usage file.”

According to the combination of *Kita* and *Gang*, one of ordinary skill in the art at the time of Applicant's invention would have found using stored user preferences obvious to
25 reduce the time required for a user to select new music from a music distribution server.

See the rejection of claim 21, *supra*. Furthermore, *Gang* discloses that in providing user preferences, the user provides feedback to update the preferences. *Gang* at ¶ 77-78.

Such feedback includes metadata, such as whether a song has been played, is recorded in the player device and then uploaded to the content provider. *Id.* The music source

5 updates its stored user preferences and then provides a new recommendation. See *id.*

Therefore, *Kita* in view of *Gang* makes obvious all limitations of the claim.

Claim 39 is limited to the player of claim 21. This claim requires the following:

“an interface associated with the player for receiving user preference information and transmitting it via a wireless transceiver link to the content source.”

10 According to the combination of *Kita* and *Gang*, one of ordinary skill in the art at the time of Applicant's invention would have found using stored user preferences obvious to reduce the time required for a user to select new music from a music distribution server.

See the rejection of claim 21, *supra*. Furthermore, *Gang* discloses that in providing user preferences, the user provides feedback to update the preferences. *Gang* at ¶ 77-78.

15 Such feedback includes metadata derived from indirect sources, *id.*, but other metadata is more direct and based on input provided through an interface associated with the player.

Id. at ¶ 100. Therefore, *Kita* in view of *Gang* makes obvious all limitations of the claim.

Claim 40 is limited to the player of claim 21. This claim requires the following:

20 “a docking station with two or more of the following interfaces...a docking connector power interface...[and] a docking connector data interface...wherein the player is easily mounted to and dismounted from the docking station providing power to the player via said docking connector power interface...[and] a data interface to an external computer via said docking connector data interface...”

Kita likewise discloses a docking station 800 with an interface 825 providing power and data. *Kita* at ¶¶ 127-28, fig.4. Therefore, *Kita* in view of *Gang* makes obvious all limitations of the claim.

2. **Claim 33 is rejected under 35 U.S.C. 102(b) and 103(a) as being unpatentable**
5 **over *Kita* in view of *Gang* and further in view of US Patent Application**
Publication 2003/0236582 A1 (filed 25 June 2002) (“*Zamir*”).

Claim 33 is limited to the player of claim 31. This claim requires the following:

10 “wherein the usage file comprises information on the frequency of playback of content files, skipping of content files and failure to play content files to completion and the content source modifies the stored user content preferences in response to said information.”

Gang teaches tracking user behavior in order to provide implicit feedback concerning the user’s music preferences. *Gang* at ¶ 78. The user behavior tracked includes playing a file, saving music and buying music, but *Gang* discloses that any other type of implicit
15 feedback is usable. *Id.* Other types of user behavior known in the art to be suitable for providing implicit feedback concerning a user’s preference includes skipping over files before they complete and whether a file successfully plays to the end. *Zamir* at ¶¶ 232-38. Each of these events is associated with a weight, such that a song played frequently will receive a higher weight than a song played less frequently, or skipped. *See id.* at ¶¶
20 240-260. In this way, *Zamir* expressly teaches tracking whether a song is skipped or fails to play to the end and implicitly teaches tracking the frequency at which a song is played. Accordingly, since *Gang* allows for other types of user behavior to be tracked besides that disclosed and *Zamir* teaches the claimed user behaviors suitable for implicitly

defining a user's music preferences, the claimed usage file is obvious. Therefore, *Kita* in view of *Gang* and further in view of *Zamir* makes obvious all limitations of the claim.

3. Claims 34-37 are rejected under 35 U.S.C. 102(b) and 103(a) as being unpatentable over *Kita* in view of *Gang* and further in view of US Patent 6,782,239 B2 (filed 21 June 2002) ("*Johnson*").

Claim 34 is limited to the player of claim 21. This claim requires three elements as follows:

"a playback device for creating a playback signal from the stored media content; a playback transmitter for short range broadcast transmission of the playback signal modulated onto a broadcast signal; and a frequency selector for surveying ambient broadcast transmissions and, responsive to the ambient broadcast transmissions, selecting a broadcast signal frequency for the playback transmitter that reduces interference between the selected broadcast signal and the ambient broadcast transmissions."

Kita discloses both a music data decoder 211 and music output 212 that operates just as the first element of this claim to create a playback signal from stored media content from memory card 209. *Kita* at ¶ 113. In addition, *Kita* discloses providing a radio transmission adapter 2500 that corresponds to the claimed playback transmitter that modulates audio for broadcast. *Id.* at ¶ 281. However, *Kita* does not disclose the claimed frequency selector. Despite this deficiency of *Kita*, one of ordinary skill in the art would have found it obvious at the time of Applicant's invention to provide a clear channel selector as claimed within radio transmission adapter 2500 of *Kita*. Specifically, *Johnson* expressly teaches that such a device relieves a user from the burden of manually scanning for available radio broadcasting channels. *Johnson* at col. 1 ll. 27-44, 66-67, col. 2 ll. 1-

8. Therefore, *Kita* in view of *Gang* and further in view of *Johnson* makes obvious all limitations of the claim.

Claim 35 is limited to the player of claim 34. This claim requires that the playback signal is an audio signal and it is modulated onto an FM broadcast band signal.

- 5 *Kita* discloses providing a radio transmission adapter 2500 that corresponds to the claimed playback transmitter that modulates audio for broadcast. *Id.* at ¶ 281. Although not disclosed as an FM broadcast band signal, *Johnson* teaches that radio transmitters like that disclosed in *Kita* generally use FM transmission for communicating between a portable player and a radio receiver. *Johnson* at Abstract. Therefore, *Kita* in view of
- 10 *Gang* and further in view of *Johnson* makes obvious all limitations of the claim.

Claim 36 is limited to the player of claim 34. This claim requires the following:

“wherein the frequency selector comprises a broadcast band receiver, said broadcast band receiver adapted also to provide music for realtime or near-realtime playing on the player or for processing and storing as a content file.”

- 15 According to the rejection of claim 34, one of ordinary skill in the art at the time of Applicant’s invention would have found providing a clear channel selection mechanism as taught by *Johnson* within the radio adapter 2500 of *Kita*. *Johnson* discloses that its clear channel selection mechanism also operates as a broadcast band receiver that can provide realtime playing. *Johnson* at col. 6 ll. 49-55. Therefore, *Kita* in view of *Gang*
- 20 and further in view of *Johnson* makes obvious all limitations of the claim.

Claim 37 is limited to the player of claim 35. This claim requires the following:

“a headphone connector and a sensor operatively connected to the headphone connector for inhibiting operation of the playback transmitter when a headphone is connected to the headphone connector.”

Kita discloses that the radio transmission adapter 2500 detects whether headphones 2600 are connected and accordingly disables transmission of a playback signal from decoder section 211 and music output section 212. *See Kita* at ¶ 285. Therefore, *Kita* in view of *Gang* and further in view of *Johnson* makes obvious all limitations of the claim.

- 5 **4. Claim 38 is rejected under 35 U.S.C. 102(b) and 103(a) as being unpatentable over *Kita* in view of *Gang* in view of *Johnson* and further in view of US Patent 5,161,251 (patented 03 November 2001) (“*Mankovitz*”).**

Claim 38 is limited to the player of claim 38. This claim requires the following:

- 10 “an encoder and means for accessing text data in metadata associated with the stored media content and transmitting the text data for reception in coordination with the selected broadcast signal, wherein the encoder encodes according to RDS or equivalent.”

- None of the prior art cited in the foregoing discloses transmitting text data in metadata along with a broadcast signal according to RDS or the equivalent. However, transmitting
15 textual metadata, such as song title, artist name and album name, along with the song’s audio component is well known within the art of broadcasting audio by radio and one of ordinary skill in the art at the time of Applicant’s invention would have found modifying the radio transmission adapter 2500 of *Kita* to broadcast textual metadata according to the teachings of *Mankovitz* obvious. Therefore, *Kita* in view of *Gang* in view of *Johnson* and
20 further in view of *Mankovitz* makes obvious all limitations of the claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WALTER F. BRINEY III whose telephone number is (571)272-7513. The examiner can normally be reached on M-F 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Walter F. Briney III/
Primary Examiner
Art Unit 2614